

## REMARKS

Appreciation is hereby expressed to Examiner Berman for the interview so courteously granted on September 26, 2005. Pursuant to that interview, Claim 11 has been cancelled and the third paragraph on page 5 of the Specification has been corrected. Support for the correction of the Specification can be found in the original Claim 2. The present amendment is deemed not to introduce new matter, raise new issues or necessitate a new search. Claims 1, 3, 5-8, and 10-21 remain in the application.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 5-8, 10 and 12-21 under 35 U.S.C. 112, first paragraph, on the ground that the Specification is not enabling for a tensile shear modulus in the range of  $10^5$  to  $10^7$ . The Specification, third paragraph on page 5, has been corrected to refer to the "dynamic shear modulus" rather than "dynamic tensile modulus". Support for this change can be found in the application, original Claim 2. It is therefore believed that the rejection is moot, and the Examiner would therefore be justified in no longer maintaining this rejection.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 5-8, 10 and 12-21 under 35 U.S.C. 112, second paragraph, as being indefinite with regard to the blending proportions. In the rejection the Examiner has indicated that Claim 1 fails to set forth the total weight upon which the parts by weight are based.

It is respectfully submitted that the claims are not indefinite because the proportions of the components are clearly set forth; that is, the proportions of the compounds (B) to (D) are described as being based on 100 parts by weight of compound (A) as described in the second paragraph of page 27 of the Specification. Moreover, the proportion of the agent (E) is described as being based on

volume per cent. It is respectfully submitted that one of ordinary skill in the art would understand based on this description how to blend the various components described in the claims herein.

With respect to the Examiner's comments that component (C) fails to recite that the polymerizable group is a radiation polymerizable group, the Examiner's attention is called to the fact that component (D) in Claim 1 is described as a compound which is activated by radiation to initiate polymerization of the polymerizable group in the compound (C). On the basis of this description in Claim 1, it is respectfully submitted that one of ordinary skill in the art would understand the meaning of the claim taken as a whole. Therefore, the Examiner would be justified in no longer maintaining this rejection.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 6-8, 10, 11 and 13-21 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J 06080825 (hereinafter '825 reference).

One of the important features of the present invention recited in Claim 1 concerns the slow curing which can be achieved using the specific claimed composition with the specific viscosity, conversion ratio, dynamic shear modulus and dynamic tensile modulus. These features are disclosed in the various compositions described in the examples and are illustrated in Tables 1-7 on pages 37-45 of the Specification.

In contrast, the '825 reference merely discloses an ultraviolet curable and moisture-curable composition comprising an alkoxy silyl compound containing vinyl group, a polybutadiene diol esterified at both of its terminals with maleic anhydride, a photo-initiator and moisture curing catalyst. A feature of this composition is that it cures rapidly. This fact is supported by Examples 1-3 in Table 1. For example, in Example 1, JIS-A hardness is 30 and strength is 20 kgf/cm

immediately after irradiation, while the hardness is 20 and strength is 20 kgf/cm after moisture cure.

These properties of the composition demonstrate that the composition rapidly cures due to irradiation.

In view of this clear and unambiguous comparison, it can be seen that the '825 reference does not disclose the feature of the present invention, i.e., slow curing, and the specific composition called for in the claims herein. Further, the '825 reference does not describe the thixotropic agent (E) called for in the claims herein. It is therefore respectfully submitted that the '825 reference does not anticipate or render unpatentably obvious the present invention required by the claims herein.

It is understood that the Examiner predicates the rejection based on the '825 reference on the theory that the compositions called for in the claims herein are disclosed in the '825 reference and, therefore, would have similar properties. However, as pointed out above, the claims of the present application call for components which are nowhere disclosed in the '825 reference, i.e., the thixotropic agent (E).

The importance of the thixotropic agent (E) is illustrated in the Specification. For example, as can be seen from Tables 4 and 7, the adhesive compositions of Comparative Examples 1, 2, and 4-6, because of their exclusion of a thixotropic agent (E), exhibit inferior adhesive strength immediately after exposure to irradiation. It is therefore apparent that the thixotropic agent (E) plays an important role in affecting the properties of the composition of the present invention.

Therefore, the exclusion of a thixotropic agent (E) in the '825 reference is an important factor in considering the applicability of the '825 reference as either an anticipation or a reference showing obviousness of the present invention. In view of these comparative tests set forth in the Specification herein, it is respectfully submitted that the thixotropic agent (E) should not be ignored.

when comparing the claims of the present application with the disclosure of the '825 reference. If such a comparison is made, it is respectfully submitted that one of ordinary skill in the art would recognize the importance of the presence of the thixotropic agent in the composition called for in the claims herein. For this reason, it is respectfully submitted that the Examiner would be justified in no longer maintaining this rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 6-8, 10, 11 and 13-21 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J 06-228248 (hereinafter '248 reference).

The '248 reference, like the '825 reference discussed above, fails to disclose a composition containing a thixotropic agent as called for in the claims herein. Further, the properties of the present invention can be achieved by including 20 – 65 volume % of the agent (E) based on 100 volume % of all components (A) – (E), while the prior art does not suggest such amount of a thixotropic agent. It is therefore clear that the '248 reference fails to disclose the composition called for in the claims herein, especially one having the properties of the composition of the present invention.

For these reasons, the '248 reference fails to anticipate or render unpatentably obvious the subject matter called for in the claims herein. Consequently, the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 6-8, 10, 11 and 13-21 under 35 U.S.C. 103(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J 08-325466 (hereinafter the '466 reference).

The '466 reference is concerned with a composition to use as a sealant and, thus, the composition contains a large amount of non-transparent filler such as calcium carbonate. For example, the composition of Example 1 in the '466 reference contains 100 parts by weight of calcium carbonate and 25 parts by weight of titan oxide based on 100 parts by weight of oxypropylene polymer. Thus, the reaction due to irradiation merely occurs on the surface of the composition and the inner portion does not cure.

In contrast, in the present inventive composition, curing gradually occurs not only at the surface but also in the inner portions. Further, in the '466 prior art composition, only a small amount of the compound corresponding to the compound (C) is contained. For example, the amount of the compounds A1 to A7 shown in Tables 2 and 3 in the '466 reference, which corresponds to the compound (C), is at most 8 parts by weight. Particularly, in Examples 1 to 5 and 8, the amount of the compound A1 to A5 is 5 parts by weight, and in Examples 6 and 7, 8 parts by weight. By contrast, the amount of the compound (C) in the present invention should be at least 15 parts by weight. Thus, the prior art composition disclosed in the '466 reference does not exhibit the properties of the present invention.

Further, in the examples of the '466 reference, the photo-polymerization initiator corresponding to the compound (D) is not present, although the paragraph 0056 suggests that a photo-polymerization initiator can be added. Thus, the prior art composition of the '466 reference does not show the properties of the composition of the present invention.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 5-8 and 10-21 under 35 U.S.C. 103(a) as being unpatentable over EP 0035049 (hereinafter the '049 reference) in view of

J 55-036241 (hereinafter the ‘241 reference).

The ‘049 reference, the Examiner’s primary or principal reference, discloses a composition curable upon exposure to atmospheric moisture at room temperature to produce a cured rubber-like substance. As the Examiner recognizes in the rejection that the ‘049 reference fails to disclose a photocurable composition containing a photoinitiator for the photocurable substances as required by the claims herein.

In an attempt to cure the deficiencies of the primary reference, the Examiner then relies upon the ‘241 reference as a secondary reference to show the use of a photosensitizer. However, there is no disclosure in either the Examiner’s primary or secondary references that they could be combined in the manner suggested by the Examiner to arrive at an adhesive composition in which immediately after exposure to an active energy radiation there is a conversion of the compounds (A) and (C) in the range of 10 – 70%, and after exposure of the adhesive composition to the active energy radiation and subsequent 24-hour aging at 25°C there is a conversion of the compounds (A) and (C) in the range of 50 – 100%.

There is no suggestion in either of the references relied upon by the Examiner that they could be combined in the manner suggested by the Examiner to produce a slow-curing composition having the curing properties as called for in the very specific claims herein. Therefore, it is respectfully submitted that one of ordinary skill in the art would have no reasons to combine these references, that is, substitute the photosynthesizer in the ‘241 reference in the photocurable composition of the ‘049 reference. Without such a motivation, it is respectfully submitted that one of ordinary skill in the art would not combine these references to arrive at the composition called for in the claims

herein. For these reasons, the Examiner would be justified in no longer maintaining the rejection.  
Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance and early action and allowance thereof is accordingly respectfully requested. If there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted



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### CERTIFICATE OF MAILING

I hereby certify that this Amendment and Transmittal in Docket No. M&M-048-USA-PCT, Serial No. 10/019,433, filed December 31, 2001 was deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents  
P.O. Box 1450  
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On September 26, 2005

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